

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated November 4, 2009 (the “*Office Action*”). In the *Office Action*, Claims 7-26 are pending and rejected. Claims 7, 11, 14, and 21 have been amended. Claims 1-6 have been previously canceled. For the following reasons, Applicants respectfully request favorable action in this case.

Finality of Rejection

Applicants respectfully request withdrawal of the finality of the *Office Action* delivered November 4, 2009. The M.P.E.P provides guidelines for when a final rejection is proper on a second action:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

M.P.E.P. § 706.07(a) (emphasis added). In the present case, Applicants contend that within the *Office Action* dated November 4, 2009, the Examiner has introduced new grounds of rejection that were not necessitated by Applicants' amendment of the claims.

Specifically, Applicants note that in the previous Office Action mailed April 1, 2009, the Examiner rejected Claims 10, 17, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Caviles*. In the subsequent Response to Office Action submitted by Applicant on June 30, 2009, Applicants argued the patentability of dependent Claims 10, 17, and 24 over *Caviles*. Applicants did not amend dependent Claims 10, 17, and 24 or the independent claims from which these claims depend. In the *Final Office Action*, the Examiner rejects the Claims 10, 17, and 24 over *Caviles* in view of U.S. Patent Application Publication No. 2002/0062259 issued to Katz (“*Katz*”). Thus, the proposed *Caviles-Katz* combination, as applied to Claims 10, 17, and 24, is a new ground of rejection. The Examiner states that “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office Action.” (*Office Action*, page 7). However, since Applicants’ Claims 10, 17, and 24 were not amended in the Response to Office Action submitted on June 30, 2009, the new grounds

of rejection provided by the Examiner in the final *Office Action* could not have been necessitated by Applicants' amendment to the claims. As such, Applicants contend that the Examiner has introduced a new ground of rejection to Claims 10, 17, and 24, which were not necessitated by Applicants' amendment of the claims. Applicant respectfully submits that the finality of the *Office Action* mailed November 4, 2009 is improper.

For at least these reasons, Applicants respectfully request that the finality of the *Office Action* dated November 4, 2009, be withdrawn.

Section 102 Rejections

The Examiner rejects Claims 7-9, 14-16, and 21-23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,752,313 issued to Caviles et al. ("Caviles"). Applicants traverse the rejection of these claims for the reasons discussed below.

Initially, Applicants note that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. ch. 2131. "The ***identical invention*** must be shown in as ***complete detail as contained*** in the . . . claim ." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added); see also M.P.E.P. ch. 2131. In addition, "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. ch. 2131.

The Federal Circuit recently clarified this standard in *Net Moneyin, Inc. v. Verisign, Inc.*, 2008 WL 4614511 (Fed. Cir. 2008). In *Net Moneyin*, the Federal Circuit held that a finding of anticipation under 35 U.S.C. § 102 is proper only when a "reference discloses within the four corners of the document not only all of the limitations claimed but also ***all of the limitations arranged or combined in the same way*** as recited in the claim." *Net Moneyin* at *10 (emphasis added). The prior art reference must "***clearly and unequivocally*** disclose the claimed invention ... ***without any need for picking, choosing, and combining various disclosures not directly related to each other*** by the teachings of the cited reference." *Id.* (emphasis added, internal typographical notations omitted).

Independent Claim 7 of the present Application, as amended, recites:

A method for use in a Web Services system comprising:
providing a data repository storing a hierarchy of objects;
storing at least one first Business Service object under a first Business Entity object identifying a first business entity, the first Business Service object identifying a business service that is provided by the first business entity;
storing a Business Service Projection object under a second Business Entity object identifying a second business entity, the Business Service Projection object identifying that the second business entity offers an interface to the business service provided by the first business entity;
using the interface offered by the second business entity to project the business service provided by the first business entity as being provided by the second business entity;
using one or more processing systems to receive a modification to the first Business Service object; and
using the one or more processing systems to automatically modify the Business Service Projection object in response to receiving the modification to the first Business Service object.

Thus, Claim 7 has been amended to incorporate feature previously recited in dependent Claim 11. It continues to be Applicants' position that the prior art of record does not disclose, either expressly or inherently, each and every element of the claims.

For example, the cited references do not disclose, teach, or suggest "using the interface offered by the second business entity to project the business service provided by the first business entity as being provided by the second business entity," as recited in Claim 7. As previously shown by Applicants, *Caviles* "relates to method and system for rapidly establishing credit card merchant accounts (MAs) whereby merchants can begin processing credit card transactions or exchanging other data pertinent to such transactions nearly instantaneously after applying for a merchant account." (*Caviles*, Figure 3; Column 1, lines 12-17; Column 5, lines 44-45; Column 8, lines 30-44). Figure 1 of *Caviles*, as relied upon by the Examiner, merely depicts "a schematic diagram of a typical set-up for processing credit card transactions over the Internet." (*Caviles*, Column 2, lines 14-16). During the processing of a credit card transaction, *Caviles* discloses the following process:

During the course of an Internet transaction, a payment page is sent from the merchant 12 to the on-line customer 18 and displayed by the customer's Internet browser. The customer enters his or her credit card number, the expiration date of the card, and the purchase amount in the designated fields of the payment page and selects a transmit function . . .

The browser transmit function sends the transaction data . . . to an Internet gateway 16 designated by the [Gateway Identification Number (GID)] associated with the merchant account] embedded within the payment page. The gateway directs the transaction to front-end processing center 24, also identified by the GID . . .

Once the transaction data reaches the front-end system 24, the transaction proceeds in the convention manner. The front-end processing center accumulates transactions throughout each business day. At the end of each day the front-end processing center batches the captured transactions to the various acquiring banks associated with the merchants whose transaction have been accumulated . . .

Once the acquiring bank receives the batched transactions, the bank performs an automated clearinghouse function on the transactions (ACH). As part of the ACH, the acquiring bank batches transaction files to each of the card issuing banks whose credit card holders have entered transactions captured by the front-end processing center and forwarded to the acquiring bank. The issuing banks post the transactions to their cardholders' accounts to be listed on the cardholders' monthly statements . . .

(*Caviles*, Column 2, line 37 through Column 3, line 14). Thus, Figure 1 of *Caviles* merely depicts a schematic diagram of the system and parties used to process a conventional credit card transaction. There is no disclosure of “using the interface offered by the second business entity to project the business service provided by the first business entity as being provided by the second business entity,” as recited in Claim 7.

In the *Office Action*, the Examiner identifies the “acquiring bank” and the “issuing bank” as being analogous to Applicants’ first and second business entities. (*Office Action*, pages 2-3). The Examiner also identifies the credit card as being analogous to Applicants’ “interface.” (*Office Action*, page 3). Applicants respectfully disagree. Even to the extent that the credit card is provided by an issuing bank, there is no disclosure in *Caviles* of using a credit card offered by the issuing bank to project a business service provided by the acquiring bank as being provided by the issuing bank. As such, *Caviles* does not disclose, teach, or suggest “using the interface offered by the second business entity to project the business service provided by the first business entity as being provided by the second business entity,” as recited in Claim 7.

For at least these reasons, Applicants respectfully request consideration and allowance of independent Claim 7, together with Claims 8-13 that depend on Claim 7. For analogous reasons, Applicants also request consideration and allowance of independent

Claims 14 and 21, together with Claims 15-20 and 22-26 that depend on Claims 14 and 21, respectively.

Section 103 Rejections

The Examiner rejects Claims 10, 17, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Caviles* in view of U.S. Patent Application Publication No. 2002/0062259 issued to Katz et al. (“*Katz*”). The Examiner rejects Claims 11, 12, 18, 19, and 25 under 35 U.S.C. § 103(a) as being unpatentable *Caviles* in view of U.S. Patent Application Publication No. 2002/0124003 issued to Rajasekaran et al. (“*Rajasekaran*”). The Examiner rejects Claims 13, 20, and 26 under 35 U.S.C. § 103(a) as being unpatentable *Caviles* in view of U.S. Patent No. 6,571,232 issued to Goldberg et al. (“*Goldberg*”). Applicants traverse the rejection of these claims for the reasons discussed below.

Dependent Claims 10, 12, and 13 depend on Claim 7. Claims 17-20 and 24-26 depend upon Claims 14 and 21, respectively. Accordingly, dependent Claims 10, 12-13, 17-20, and 24-26 are not obvious over the proposed combinations at least because Claims 10, 12-13, 17-20, and 24-26 include the limitations of their respective independent claims, which Applicants have shown above to be allowable. Since Claims 10, 12-13, 17-20, and 24-26 incorporate the limitations of their respective independent claims, Applicants have not provided detailed arguments with respect to Claims 10, 12-13, 17-20, and 24-26. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 10, 12-13, 17-20, and 24-26.

Claim 11 has been rewritten in independent form to include the limitations recited in Claim 7 prior to any amendment in this Response to Office Action. Applicants respectfully submit that the proposed *Caviles-Rajasekaran* combination, as relied upon by the Examiner, does not disclose, teach, or suggest the each and every element recited in Applicant’s now independent Claim 11.

For example, the proposed *Caviles-Rajasekaran* combination does not disclose, teach, or suggest “searching the data repository for services provided by the second business entity and returning the business service provided by the first business entity,” as recited in Claim 11. In the *Office Action*, the Examiner acknowledges that *Caviles* does not disclose the recited claim elements and instead relies upon *Rajasekaran*. (*Office Action*, page 4). However, *Rajasekaran* merely discloses a method for determining if a query element is in a

set of elements. (*Rajasekaran*, Abstract). More specifically, *Rajasekaran* discloses, receiving information identifying elements of set S , building a data structure to facilitate searching, receiving a search request to determine if a search query element K is included in set S , using the data structure to determine if the search query element k is included in set S , and indicating whether or not element k was found in set S . (*Rajasekaran*, Figure 2; Paragraphs 36-41). Thus, *Rajasekaran* merely discloses identifying k in set S . The mere execution of a search of an identified set for a element within that set is not analogous to Applicants' claim language. Specifically, there is no disclosure, however, of "searching the data repository for services provided by the second business entity and returning the business service provided by the first business entity," as recited in Claim 7. The recited claim elements are absent from the disclosures of both *Caviles* and *Rajasekaran* and not obvious over their proposed combination.

For at least these reasons, Applicants respectfully request consideration and allowance of independent Claim 11.

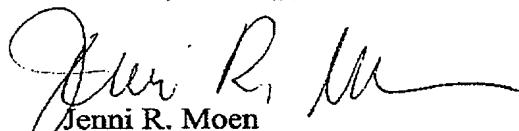
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge \$220.00 for an additional independent claim to Deposit Account No. 02-0384 of Baker Botts L.L.P. No other fees are believed due; however, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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